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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,870	03/10/2004	Rieko Takahashi	KON-1858	3710

20311 7590 07/28/2006

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

GILLIAM, BARBARA LEE

ART UNIT PAPER NUMBER

1752

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No.	Applicant(s)	
	10/797,870	TAKAHASHI ET AL.	
	Examiner	Art Unit	
	Barbara L. Gilliam	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/15/2006 & 3/28/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2006 has been entered.
2. The response and declaration submitted on March 28, 2006 has been fully considered.
3. The supplemental response and declaration submitted on May 15, 2006 has also been fully considered.
4. Claims 1-20 are present.

Terminal Disclaimer

5. The terminal disclaimer filed on February 17, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/943,935 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1752

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for plastic flexible supports, does not reasonably provide enablement for non-plastic flexible supports. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Although the specification states that commonly known flexible supports are used as the substrate, only plastic film supports are discussed in detailed and exemplified.

Claim Rejections - 35 USC § 102 & 35 USC § 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inoue et al. (EP 1 145 848 A2).

Art Unit: 1752

a. The lithographic printing plate precursor of Inoue et al. anticipates the presently claimed printing plate material. Specifically Inoue et al. teach a lithographic printing plate material comprising a hydrophilic support having thereon a heat-sensitive layer containing at least one of a thermoplastic particulate polymer, a particulate polymer having a heat-reactive group and a microcapsule containing a compound having a heat-reactive group incorporated therein (abstract; [0014]-[0062]). The support is dimensionally stable and can be made of various materials including paper, paper laminated with plastic (e.g., polyethylene, polypropylene, polystyrene), plastic film (polyethylene terephthalate) and a metal plate (aluminum) ([0108]-[0110]; [0155]). The support may be coated with a hydrophilic layer preferably comprising a colloid made of a sol-gel conversion material of oxide or hydroxide of beryllium, magnesium, aluminum, silicon, titanium, boron, germanium, tin, zirconium, iron, vanadium) and a hydrophilic resin ([0158]-[0164]). This hydrophilic layer meets the present limitations for the same. An interlayer can further be provided ([0147]; [0172]) which meets the present limitations for the same. A light to heat converting agent can be present in the heat-sensitive layer or layers adjacent thereto ([0088]-[0107], [0157]). The lithographic printing plate precursor is exposed to laser beam at a high output, preferably a laser which emits light in the infrared or near infrared, mounted untreated on the cylinder of a printing machine and subject to fountain solution and ink ([0173]-[0176]). Inoue et al. do not teach the La^*b^* value, the transmission density of the hydrophilic layer however, Inoue et al. clearly teach flexible supports including paper, paper laminated with plastic, plastic films and metal supports. It is the Examiner's position the supports, coated with

Art Unit: 1752

the preferred hydrophilic layer, exhibit a transmission density and said transmission density are expected to at least come close to the claimed range of the present application absent any evidence to the contrary. Alternatively, it would have been obvious to one of ordinary skill in the art to choose any of the flexible supports taught by Inoue et al. such as the plastic support and coat said support with the preferred hydrophilic layer. It is the Examiner's position the combination is expected to have a transmission density at least close to the claimed range. Further, the heat-sensitive layer of Inoue et al. comprises materials at least one of a thermoplastic particulate polymer, a particulate polymer having a heat-reactive group and a microcapsule containing a compound having a heat-reactive group incorporated therein all of which meet the present limitations for the heat-melting material. Absent any evidence to the contrary, it is the Examiner's position the heat-sensitive layer will exhibit a glossiness within, overlapping or close to the claimed range for the image forming layer. Applicant is reminded of MPEP 2112.

Response to Arguments

11. Applicant's arguments filed March 28th, 2006 and May 15th, 2006 have been fully considered but they are not persuasive.

a. In the March 28th, 2006 response, Applicant argued the rejection under 35 USC 112, 1st paragraph. Although the Examiner had not set forth said rejection yet, Applicant's response to the rejection is appreciated since it was mentioned on the Advisory Action of March 13th, 2006. The rejection under 35 USC 112, 2nd paragraph is

Art Unit: 1752

withdrawn. The Examiner maintains the specification is enabled for flexible plastic supports and but for not any flexible non-plastic support.

b. With respect to Inoue et al., Applicant argued the material of Inoue was tested and does not inherently meet the transmission density limitation. The Declaration dated March 1, 2006 tested a single aluminum support and concluded that said support did not transmit light. Again, Inoue et al. teach dimensionally stable supports made of various materials including paper, paper laminated with plastic (e.g., polyethylene, polypropylene, polystyrene), plastic film (polyethylene terephthalate) and a metal plate (aluminum) ([0108]-[0110]; [0155]). A hydrophilic layer coated on the support is clearly taught wherein the hydrophilic layer preferably comprising a colloid made of a sol-gel conversion material of oxide or hydroxide of beryllium, magnesium, aluminum, silicon, titanium, boron, germanium, tin, zirconium, iron, vanadium) and a hydrophilic resin ([0158]-[0164]). It is within the scope of Inoue et al. to coat any of the supports taught therein including the plastic supports with the preferred hydrophilic layer. The Applicant has not compared any other type of support and certainly did not compare a plastic support coated with the hydrophilic layer. Applicant clearly noted on page 5 of the March 28th response "that the transmission density limitation is affected by not only the flexible support but by the hydrophilic layer" and on page 2 of the response of May 15th, that transmission density is being measured across the flexible support, the underlayer(s) (if present) and the hydrophilic layer.

c. With respect to the May 15th response and declaration, Applicant's inventive example is not commensurate in scope with the claims. There is no specific

Art Unit: 1752

support (plastic vs. metal), no specific underlayer or specific hydrophilic layer claimed in the broad claims. (The underlayer of sample 5B contains colloidal silica, porous metal oxide lamellar mineral particle montmorillonite, Cu-Fe-Mn metal oxide black pigment, aqueous 4% solution of sodium carboxymethyl cellulose and aqueous solution of sodium phosphate and the hydrophilic layer contains colloidal silica, necklace-form colloidal silica, two types of porous metal oxide particles of different sizes, lamellar mineral particle montmorillonite, Cu-Fe-Mn metal oxide black pigment, aqueous 4% solution of sodium carboxymethyl cellulose and aqueous solution of sodium phosphate). Inoue et al. teaches at least the hydrophilic layer with sufficient specificity. Additionally, sample 5B differs from sample 5A in that the polymer of the heat-sensitive layer was replaced with 14.23 grams of paraffin wax emulsion H808. It is not clear why this was done. There is no claim to the paraffin wax emulsion. Therefore the Examiner finds the declaration results inconclusive. Applicant also mentioned unexpected results.

Applicant is reminded of MPEP 2131.04: "Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based." *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). With respect to the rejection under 35 USC 103(a), the Examiner finds that the results are not commensurate in scope with the claims. MPEP 716.02(d): "Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is

Art Unit: 1752

offered to support." *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

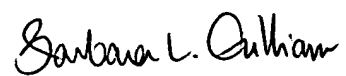
a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/797,870

Page 9

Art Unit: 1752

A handwritten signature in black ink, reading "Barbara L. Gilliam". The signature is written in a cursive style with a large, stylized initial 'B'.

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
July 24, 2006